

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
AT TACOMA

PACTOOL INTERNATIONAL LTD.,

**Plaintiff,**

V.

KETT TOOL COMPANY INC., et al.,

## Defendants.

CASE NO. C06-5367BHS

**ORDER GRANTING IN PART  
AND DENYING IN PART  
PLAINTIFF'S MOTION FOR  
PARTIAL SUMMARY  
JUDGMENT OF  
LITERAL INFRINGEMENT**

This matter comes before the Court on Plaintiff PacTool International Ltd.’s (“PacTool”) motion for partial summary judgment of literal infringement (Dkt. 59). The Court has considered the pleadings filed in support of and in opposition to the motion and the remainder of the file and hereby grants in part and denies in part the motion for the reasons stated herein.

## **I. PROCEDURAL AND FACTUAL BACKGROUND**

This action was filed on June 29, 2006. Dkt. 1. This is a patent case arising under federal patent law. *See generally* Dkt. 63. This Court has original subject matter jurisdiction over the action pursuant to 28 U.S.C. §§ 1331 (federal question jurisdiction) and 1338(a) (an Act of Congress governing patent cases). PacTool’s amended complaint alleges that Defendant Kett Tool Company Inc. (“Kett”) and H. Rowe Hoffman (“Hoffman”) have been and are infringing – directly, contributorily and/or by inducement – technology contained in patents owned by PacTool by manufacturing, using, selling

1 and/or offering for sale products that infringe such technology. Dkt. 63 at 3-6. The  
2 products at issue contain fiber-cement cutting technology that PacTool maintains is  
3 protected by its patents. *Id.* at 2.

4       In December of 2007, Kett requested reexamination of the patents-in-suit in the  
5 United States Patent and Trademark Office. *See* Dkt. 30. On February 1, 2008, the Court  
6 granted Kett's request for a stay of this litigation until the reexamination procedures were  
7 completed. Dkt. 39. The reexamination proceedings were terminated in December of  
8 2009 and the stay was terminated on December 18, 2009. *See* Dkt. 48. On April 1, 2010,  
9 the Court granted PacTool's motion to amend its complaint to add Hoffman as a  
10 Defendant. Dkt. 61.

11       On March 25, 2010, PacTool filed a motion for partial summary judgment of  
12 literal infringement. Dkt. 59. On April 12, 2010, Kett filed a response (Dkt. 66) and on  
13 April 16, 2010, PacTool replied (Dkt. 71).

14       On April 26, 2010, Defendants filed their motion requesting the Court to dismiss  
15 or transfer this action for improper venue, or in the alternative, to transfer this action to  
16 the Southern District of Ohio pursuant to 28 U.S.C. § 1404. Dkt. 75. Further, Hoffman  
17 requested that the Court dismiss or transfer the causes of action against him for lack of  
18 personal jurisdiction and/or for failure to state a claim upon which relief can be granted.  
19 *Id.* On July 7, 2010, the Court issued an order granting in part and denying in part Kett  
20 and Hoffman's motion and transferred the case to the Southern District of Ohio. Dkt. 93.  
21 On July 8, 2010, Kett filed a statement noting the death of Hoffman. Dkt. 94. On July  
22 14, 2010, PacTool filed a motion for reconsideration of the Court's order regarding  
23 transfer. Dkt. 96. On August 25, 2010, the Court granted PacTool's motion and  
24 reopened the case. Dkt. 103.

25       On September 23, 2010, the Court ordered the parties to file briefing on whether it  
26 was necessary for the Court to conduct a claim construction proceeding prior to deciding  
27 PacTool's motion for partial summary judgment. Dkt. 106. After considering the parties'  
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1 submissions, on December 15, 2010, the Court issued an order in which it concluded that  
 2 claim construction was not necessary for the Court to decide PacTool's motion for partial  
 3 summary judgment of literal infringement (Dkt. 129) and renoted PacTool's motion (Dkt.  
 4 59), which is now before the Court.

## 5 II. DISCUSSION

### 6 A. Summary Judgment Standard

7 Summary judgment is proper only if the pleadings, the discovery and disclosure  
 8 materials on file, and any affidavits show that there is no genuine issue as to any material  
 9 fact and that the movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c).  
 10 The moving party is entitled to judgment as a matter of law when the nonmoving party  
 11 fails to make a sufficient showing on an essential element of a claim in the case on which  
 12 the nonmoving party has the burden of proof. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323  
 13 (1986). There is no genuine issue of fact for trial where the record, taken as a whole,  
 14 could not lead a rational trier of fact to find for the nonmoving party. *Matsushita Elec.*  
 15 *Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986) (nonmoving party must  
 16 present specific, significant probative evidence, not simply "some metaphysical doubt").  
 17 See also Fed. R. Civ. P. 56(e). Conversely, a genuine dispute over a material fact exists if  
 18 there is sufficient evidence supporting the claimed factual dispute, requiring a judge or  
 19 jury to resolve the differing versions of the truth. *Anderson v. Liberty Lobby, Inc.*, 477  
 20 U.S. 242, 253 (1986); *T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors Ass'n*, 809 F.2d  
 21 626, 630 (9th Cir. 1987).

22 The determination of the existence of a material fact is often a close question. The  
 23 Court must consider the substantive evidentiary burden that the nonmoving party must  
 24 meet at trial – e.g., a preponderance of the evidence in most civil cases. *Anderson*, 477  
 25 U.S. at 254; *T.W. Elec. Serv., Inc.*, 809 F.2d at 630. The Court must resolve any factual  
 26 issues of controversy in favor of the nonmoving party only when the facts specifically  
 27 attested by that party contradict facts specifically attested by the moving party. The

1 nonmoving party may not merely state that it will discredit the moving party's evidence at  
 2 trial, in the hopes that evidence can be developed at trial to support the claim. *T.W. Elec.*  
 3 *Serv., Inc.*, 809 F.2d at 630 (relying on *Anderson, supra*). Conclusory, nonspecific  
 4 statements in affidavits are not sufficient, and missing facts will not be presumed. *Lujan*  
 5 *v. Nat'l Wildlife Fed'n*, 497 U.S. 871, 888-89 (1990).

## 6 **B. Literal Infringement**

7 Determining patent infringement requires that a court determine whether someone  
 8 (1) without authority (2) makes, uses, offers to sell, sells, or imports (3) the patented  
 9 invention (4) within the United States, its territories, or its possessions (5) during the term  
 10 of the patent. *Cyrix Corp. v. Intel Corp.*, 77 F.3d 1381 (Fed. Cir. 1996). Typically,  
 11 determining whether a claim in a patent has been infringed is a two-step process. *Baxter*  
 12 *Healthcare Corp. v. Spectramed, Inc.*, 49 F.3d 1575. First, it is necessary to determine  
 13 what the words in the claim mean. *Markman v. Westview Instr. Inc.*, 517 U.S. 370, 374  
 14 (1996). Second, once a claim is interpreted, it is necessary to determine if the claim  
 15 covers the accused device. *Id.* "Literal infringement of a claim exists when every  
 16 limitation recited in the claim is found in the accused device, i.e., when the properly  
 17 construed claim reads on the accused device exactly." *Strattec Sec. Corp. v. General*  
 18 *Auto. Specialty Co.*, 126 F.3d 1411, 1418 (Fed. Cir. 1997).

19 Here, although Kett has argued that the Court should conduct a claim construction  
 20 hearing in this case (*see* Dkts. 66, 113), the Court has concluded that claim construction is  
 21 not necessary to decide the instant motion as Kett has not identified any claim terms at  
 22 issue in the motion that need to be construed. *See* Dkt. 129. Accordingly, the issue of  
 23 literal infringement, for purposes of deciding PacTool's motion, turns on whether the  
 24 accused devices infringe the claims as written. *See Baxter*, 49 F.3d at 1583.

25 The claims at issue in the instant motion are Claim 16 of the '303 Patent and  
 26 Claims 10 and 19 of the '998 Patent. Dkt. 59 at 10-17. In PacTool's motion, it lays out a  
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1 chart separating the claims into elements and explains how each element reads on the  
2 accused devices. *Id.*

3       **1.      Accused Devices**

4       There are two groups of accused devices that PacTool maintains infringe on its  
5 claims. The first is represented by Kett Model KC-193. The Court concludes that Kett's  
6 argument that this model has been discontinued is irrelevant to whether the device  
7 infringed on PacTool's claims as Kett does not argue that the KC-193 was still being sold  
8 after the '303 and '998 patents were issued. *See* 35 U.S.C. § 271(6) (stating that  
9 infringement is measured from the date of issuance of a patent).

10       Next, PacTool maintains that the evidence it has presented establishes that the  
11 second group of accused devices, depicted in Bates KETT03295 and KETT0331-32 (Dkt.  
12 59-3 at 46, 48-49), are "representative of all of Kett's fiber-cement cutting shears." Dkt.  
13 71 at 12. While Kett makes an argument that the conversation between counsel for  
14 PacTool and counsel for Kett should not be used for evidence and alludes to the fact that  
15 this conversation may have been for purposes of settlement, Kett does not present any  
16 evidence that the statement is false or was made during a settlement discussion.  
17 Moreover, Kett never alleges that the statement is false, but simply states that PacTool  
18 has not proven the statement to be true. In addition, counsel for PacTool submitted a  
19 declaration stating that the statement at issue did not take place during settlement  
20 discussions. Dkt. 71-2 at 2. Therefore, based on the evidence presented and Kett's lack  
21 of response, the Court concludes that PacTool has established that Kett's accused devices,  
22 depicted in Bates KETT03295 and KETT0331-32 (Dkt. 59-3 at 46, 48-49), are  
23 representative of all Kett's fiber-cement cutting shears currently sold (Dkts. 59-2 at 1-2,  
24 71 at 12 & 71-2 at 2).

25       **2.      Preamble to Claim 16 of the '303 Patent and Claims 10 and 19 of the  
26 '998 Patent**

27       The preamble to Claim 16 of the '303 patent and Claims 10 and 19 of the '998  
28 patent are identical to each other and consist of the following language: "A fiber-cement

1 cutting tool, comprising: . . . ." Dkt. 59-3 at 87, 90 and 93. Kett states in its objections to  
2 the claim charts that, with respect to these preambles, it admits that its accused devices  
3 are cutting tools but denies that they are used exclusively for cutting fiber cement. *Id.*  
4 However, the fact that Kett's accused devices are not used exclusively for fiber-cement  
5 cutting does not defeat PacTool's argument that they literally infringe the claims because  
6 Kett's products, when used to cut fiber cement, still fit within the language stated in the  
7 preambles. Therefore, Kett's objection to the preamble language does not defeat  
8 PacTool's motion regarding literal infringement.

9       **3.      Claim 16 of the '303 Patent**

10       Kett admits that, with the exception of two elements, all other elements of Claim  
11 16 of the '303 Patent are infringed by Kett's accused devices. Dkt. 59-3 at 87-89. Kett's  
12 objection regarding these elements is that its accused devices do not infringe Claim 16  
13 because the spacing of the devices falls outside the range listed in Claim 16. Dkt. 66 at  
14 14. The element at issue in Claim 16 states as follows: "the first side surface being  
15 spaced apart from the first interior by 0.04 to 0.055 inches and the second side surface  
16 being spaced apart from the second interior surface by 0.04 to 0.055 inches." Dkt. 59-3 at  
17 88-89. PacTool contends that, according to the deposition testimony of Kett's past and  
18 present presidents, William Berlier and Kathy Conlon, the actual spacing for Kett Model  
19 KC-193 is 0.040 to 0.045 inches, which falls within the range stated in Claim 16, and that  
20 the spacing used in the KC-193 is the same used for all Kett products used to cut fiber  
21 cement. Dkt. 59 at 12. In Mr. Berlier's deposition he is asked, "[s]o are you confident  
22 that the spacing between the cutting blade in that device and the inside of the side knives  
23 is somewhere in the range of [0.04 to 0.055] inches?" Dkt. 59-3 at 52. He then answers,  
24 "I think it's very reasonable to think that." *Id.* He is then asked, "[a]nd would that be  
25 true for all of the Kett products that are used to cut fiber cement?" *Id.* Mr. Berlier then  
26 states, "Um-hum." In Ms. Conlon's deposition, she is asked, "[s]o, in fact, every tool,  
27 every fiber cement shear product that Kett manufactures and sells with the thin blade will

1 have a gap of [0.04 to 0.045] inches, correct?" *Id.* at 58. Counsel for Kett then objects,  
 2 stating that the question assumes facts not in evidence and lacks foundation. *Id.* Ms.  
 3 Conlon then states, "[t]he [0.038] to the [0.043] the way I'm reading it is on the blade  
 4 itself, so that would be adding the [0.02]. Yes, that would be within that range." *Id.* Ms.  
 5 Conlon is then asked, "[o]f [0.04] to [0.045]?" to which she answers, "Yes." *Id.*

6 In Kett's objections to the claim charts, Kett states that its accused devices do not  
 7 necessarily fit within the spacing range listed in the element of Claim 16. Dkt. 59-3 at  
 8 88-89. In Kett's response to the instant motion, it states specifically that "the distance  
 9 between the center blade and a side knife in the Kett Model KC-193 could be as small as  
 10 0.0324 inches or as large as 0.0606 inches, well outside of both of the ranges recited in  
 11 Claim 16 of the '303 patent." Dkt. 66 at 14. In support of this statement, Kett relies on a  
 12 declaration submitted by Alexander Rozumovich, Director of Engineering for Kett, in  
 13 which he states that "[t]he distance between the center blade and a side knife in the Kett  
 14 Model KC-193 could be as small as 0.0324 inches or as large as 0.0606 inches." Dkt. 65-  
 15 2 at 2. In its reply to Kett's response, PacTool maintains that Mr. Rozumovich's  
 16 statement that the spacing in Kett's KC-193 "could" be as small as 0.0324 or as large as  
 17 0.0606 inches is mere speculation and that he "offers no document, drawing, testimony or  
 18 [other] evidence to support the fact that what he suggests 'could' take place ever in fact  
 19 took place." Dkt. 71 at 13.

20 The Court concludes that, based on the answers given in the depositions of Mr.  
 21 Berlier and Ms. Conlon, and the declaration submitted by Mr. Rozumovich, a question of  
 22 fact may exist as to whether Claim 16 of the '303 patent is literally infringed by Kett's  
 23 accused devices. Specifically, the deposition testimony submitted by PacTool and the  
 24 declaration submitted by Kett appear to create a question of fact regarding the spacing of  
 25 the center blade and the side knives of the accused devices such that the Court cannot  
 26 grant summary judgment of literal infringement based on the evidence before it.  
 27 However, the Court notes that if either party has additional evidence it believes supports  
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1 its position such that this issue can be decided as a matter of law, the Court will consider  
2 a subsequent motion on the issue if filed prior to the dispositive motion deadline.

3       **4. Claims 10 and 19 of the ‘998 Patent**

4           Kett admits that, with the exception of two elements, all other elements of Claims  
5 10 and 19 of the ‘998 Patent are infringed by Kett’s accused devices. Dkt. 59-3 at 91-92,  
6 94-95. Kett’s objection to these elements is that its accused devices are used to cut one-  
7 half-inch cement board and that when they are used to cut this size board, they do not  
8 infringe on the spacing listed in Claims 10 and 19 of the ‘998 patent. The element at  
9 issue, which is identical in both Claims 10 and 19, states as follows: “wherein the first  
10 side spacing and the second side spacing are from 13% to 22% of a thickness of a fiber-  
11 cement workpiece to be cut with the blade.” PacTool asserts that Kett’s accused devices,  
12 both Kett Model KC-193 (Dkt. 59-3 at 38) and the devices depicted in Kett drawings –  
13 Bates KETT03295 and KETT0331-32 (*id.* at 46, 48-49) – literally infringe Claims 10 and  
14 19 when the devices are used to cut one-quarter inch fiber cement. Dkt. 59 at 12-17. Kett  
15 does not specifically dispute PacTool’s assertion that its accused devices infringe the  
16 spacing percentages listed in Claims 10 and 19 when cutting one-quarter-inch fiber  
17 cement; rather, Kett maintains that its devices are used to cut one-half-inch fiber cement  
18 and when doing so, do not infringe the claims. PacTool maintains that the evidence  
19 clearly shows that Kett’s devices are capable of cutting one-quarter-inch fiber cement,  
20 that Kett has not shown otherwise, and that, therefore, the accused devices literally  
21 infringe Claims 10 and 19.

22           In addition to its other arguments, Kett relies on a Federal Circuit case for the  
23 proposition that “a device that ‘is capable of being modified to operate in an infringing  
24 manner is not sufficient, by itself, to support a finding of infringement.’” Dkt. 66 at 15  
25 (quoting *Telemac Cellular*, 247 F.3d 1316, 1330 (Fed. Cir. 2001)). However, in *Telemac*,  
26 the Court of Appeals specifically relied on a restriction built into the accused device that  
27 prevented the device from infringing the patent in affirming the district court’s conclusion  
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1 that plaintiff's allegations of literal infringement failed. Here, unlike in *Tarmac*, Kett has  
2 not asserted that its accused devices are equipped with some kind of restriction that  
3 prevents them from cutting one-quarter-inch fiber cement and therefore infringing Claims  
4 10 and 19. Moreover, Kett has not specifically stated that its devices are not used to cut  
5 one-quarter-inch fiber cement; rather, it states that PacTool has not proven that the  
6 devices cut one-quarter-inch fiber cement. The Court concludes that, based on the  
7 evidence, the accused devices are capable of cutting one-quarter-inch fiber cement and  
8 may infringe on the claims as discussed below.

9       In support of its assertion that the accused devices, as depicted in Bates  
10 KETT03295 and KETT0331-32 (Dkt. 59-3 at 46, 48-49), cut one-quarter-inch fiber  
11 cement, PacTool cites to the deposition testimony of Hoffman in which he states that the  
12 accused device “[c]uts anything quarter inch on.” Dkt. 59-3 at 63. In addition, PacTool  
13 cites to Kett’s website which states that the accused device is capable of cutting fiber  
14 cement “up to 1/2” thick.” Dkt. 71-2 at 4. When the spacing given for these accused  
15 devices is compared with one-quarter-inch fiber cement, the devices literally infringe  
16 Claims 10 and 19 because they fit within the 13% to 22% limitations listed in the claims.  
17 Therefore, the Court concludes that PacTool is entitled to summary judgment of literal  
18 infringement of Claims 10 and 19 of the ‘998 patent by the accused devices as depicted in  
19 Bates KETT03295 and KETT0331-32 (Dkt. 59-3 at 46, 48-49).

20       In arguing that the KC-193 literally infringes Claims 10 and 19, PacTool relies on  
21 the deposition testimony of Mr. Berlier and Ms. Conlon, along with Kett literature for  
22 Kett Model KC-193, to show that the KC-193 is capable of cutting one-quarter-inch fiber  
23 cement and that, when doing so, infringes Claims 10 and 19. In asserting that KC-193  
24 infringes these claims, PacTool relies on the spacing for this device of 0.040 to 0.045  
25 inches, which it alleges is supported by Mr. Berlier and Ms. Conlon’s testimony. As the  
26 Court previously concluded with respect to Claim 16 of the ‘303 patent, based on the  
27 deposition testimony and the declaration of Mr. Rozumovich, there is a question of fact as  
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1 to whether the spacing in KC-193 is between 0.040 to 0.045. Therefore, the Court  
2 concludes that PacTool is not entitled to summary judgment of literal infringement of  
3 Claims 10 and 19 of the '998 patent by Kett Model KC-193. As the Court stated above, if  
4 either party wishes to present additional evidence to show that this issue should be  
5 resolved as a matter of law, the Court will consider a subsequent motion on the issue if  
6 filed prior to the dispositive motion deadline.

7 **5. Kett's Additional Arguments**

8 First, Kett's arguments regarding claim construction do not affect the Court's  
9 decision on the instant motion as the Court has ruled that claim construction was not  
10 necessary prior to deciding the motion. *See* Dkt. 129. Second, Kett's argument that the  
11 claims involved in the instant motion should have been reexamined is without merit as  
12 Kett could have sought reexamination on those claims. Third, Kett's assertions regarding  
13 judicial economy do not affect the Court's decision on the motion as the Court has  
14 discretion to rule on literal infringement while issues of invalidity and unenforceability  
15 are pending. Next, Kett's argument that PacTool's claims are invalid and/or  
16 unenforceable and that Claims 10 and 19 of the '998 patent are indefinite may be  
17 considered in a separate motion for summary judgment. Finally, Kett's contention that  
18 PacTool's motion is without merit because it is not supported by expert testimony is  
19 irrelevant as the Court has concluded that PacTool has presented evidence sufficient to  
20 support granting the motion in part. There is no specific requirement that a motion for  
21 summary judgment of literal infringement be supported by expert testimony.

### **III. ORDER**

Therefore, it is hereby **ORDERED** that PacTool’s motion for summary judgment of literal infringement (Dkt. 59) is **GRANTED in part** and **DENIED in part** as discussed herein.

DATED this 31<sup>st</sup> day of January, 2011.

  
\_\_\_\_\_  
BENJAMIN H. SETTLE  
United States District Judge